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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/594,657	05/29/2007	Hans Grundei	F0506-1US (E 2452 US)	1641
54380 7590 07/06/2009 FLASTER/GREENBERG P.C. 8 PENN CENTER 1628 JOHN F. KENNEDY BLVD. 15TH FLOOR PHILADELPHIA, PA 19103			EXAMINER MONTANO, MELISSA ANN	
			ART UNIT 3738	PAPER NUMBER
			MAIL DATE 07/06/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/594,657	<b>Applicant(s)</b> GRUNDEI, HANS	
	<b>Examiner</b> MELISSA MONTANO	<b>Art Unit</b> 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. The Amendment filed 3/30/2009 has been entered. Claims 1-14 remain pending in this application.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 4,158,895 to Reswick et al. (Reswick).

Reswick teaches a coupling for use in an apparatus for connecting a prosthesis to the bone of a stump of an amputated limb (abstract). The apparatus includes a tubular femoral socket (16) having an open lower end adapted to be inserted within the intramedullary cavity of the bone (col. 1, lines 46-48). Reswick also teaches a sleeve (spacer/bush; 20) of bio-compatible material that is carried below the socket (16), for the purpose of providing a compatible interface between the implanted socket and the skin line which heals therearound (col. 2, lines 41-44). The examiner asserts that the sleeve (spacer/bush; 20) is shown to widen out significantly from the end facing the extracorporeal direction to the end facing the intracorporeal direction and comprises a smooth surface (fig. 1). An internal annular groove (coupling element; 26) is provided for receiving balls (28) carried within a lock pin (30) for securing a prosthesis (32) to the stump (10) (col. 2, lines 64-67). The examiner asserts that this configuration would

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necessarily provide a seal in the intracorporal direction between the annular groove (coupling element; 26) and the balls of the locking pin (extracorporal coupling device; 28 in combination with 30), as claimed by applicant.

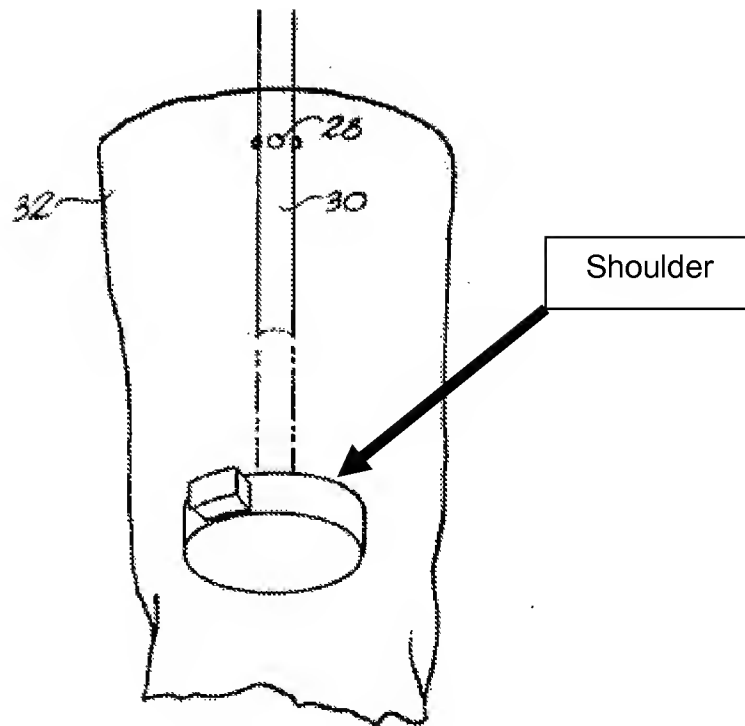
***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reswick.

Reswick teaches the mounting according to claim 1. Reswick also teaches a locking pin (adaptation tube; 30) which is shown to be configured to reach inside the sleeve (bush; 20) and be seated in an interference fit (fig. 1). The examiner asserts that the locking pin (adaptation tube; 30) is necessarily capable of being removable, if provided with the proper tools. Further, Reswick depicts the locking pin (adaptation tube; 30) as comprising a length so that it is situated with its distal front edge on a shoulder, which is formed on the extracorporal device (28 in combination with 30). See figure below.



*Fig. 1*

However, Reswick does not explicitly teach the claimed length ratio of the widening bush or specific materials used to form the components of the device.

Though Reswick does not explicitly teach the claimed length ratio, the examiner asserts that it would have been obvious to determine this ratio through routine experimentation, particularly in the absence of any disclosed criticality for the claimed ratio, in order to obtain the desired coupling strength and ease of connection. See MPEP § 2144.04. Further, it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

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Reswick also teaches that the use of any suitable bio-compatible conventional material (col. 2, lines col. 3, lines 3-5 and lines 23-32), for the purpose of providing a compatible interface between the implanted socket and the skin line which heals therearound (col. 2, lines 41-46) . Reswick discloses the claimed invention except for that the adaptation tube or bush is made from or coated with silver, titanium, silver-plating, hydroxylapatite, calcium phosphate, plasma titanium spray, polyurethane, or includes an antibacterial effect. It would have been obvious to one having ordinary skill in the art at the time of the invention to include the use of these materials, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416 (For example, see US Patent No. 4,615,705 to Scales et al., US Patent Application Publication No. 203/0171825 A1 to Blunn et al., *Cementless Titanium Tapered-Wedge Femoral Stem* by Marshall et al., and WO 99/64491 to Spaans et al.).

### ***Response to Arguments***

6. Applicant's arguments, see pages 2-7, filed 3/30/2009, with respect to the rejection(s) of claim(s) 1-14 under 35 USC 102(b) and 35 USC 103(a) have been fully considered and are persuasive. Therefore, the rejections have been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of newly applied prior art to Reswick.

***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELISSA MONTANO whose telephone number is (571)270-5785. The examiner can normally be reached on Monday-Friday 8:00AM-5:00PM EDT.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571)272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MM

/Bruce E Snow/  
Primary Examiner, Art Unit 3738